

REMARKS

Claims 1-20 were examined and reported in the Office Action. Claims 1-20 are rejected. Claims 1-12 are cancelled. Claims 12-20 are amended. Claims 12-20 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. Abstract Objections

It is asserted in the Office Action that the Abstract is objected to because it contains language used in the non-amended claims and that the language is not in narrative form. Applicant has replaced the Abstract with a new Abstract to overcome the aforementioned objections.

Accordingly, withdrawal of the informal objections for the Abstract are respectfully requested.

II. In the Drawings

Applicant adds new Figures 13-14. These Figures are based on the specification and show the male tag component of a conventional construction that has been sold in the United States in multi-millions since the early 1970's. A two piece animal identification tag having a male component with a stem with a punch at one end and a female component with an opening into which the punch can fit during assembly of the tag on the animal's ear is common knowledge of any ordinary person skilled in the art. Also, an applicator tool (or as referred to in the original specification as a "clamp," which is a literal translation from the French document) is also widely known in the art where a pair of levers and jaws are pivotally coupled together so that the jaws can mount the male and female tag components and be moved toward one another to force the punch through an animal's ear and into the opening in the female component. The term "applicator tool" is the more commonly used term. No new matter is added. Approval is respectfully requested.

III. 35 U.S.C. §112, First & Second Paragraphs

A. It is asserted in the Office Action that claims 1-20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In addition to adding new Figures 13-14, Applicant has amended the claims and the specification to overcome the 35 U.S.C. §112, first paragraph rejections.

In particular, Applicant has clarified that the sampling device is only coupled with the female tag component. Further, Applicant clarified the distinction between the male and female tag panel and what the male and female tag panel constitutes. That is, the specification and claims assert that the term panel is reserved for the part of the component onto which identification markings are applied. Applicant notes that the confusion arose do to the translation and differences in language.

Accordingly, withdrawal of the 35 U.S.C. §112, first paragraph rejections for claims 1-20 are respectfully requested.

B. It is asserted in the Office Action that claims 1 and 5 are rejected under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Applicant has cancelled claims 1 and 5. Therefore, the 35 U.S.C. §112, second paragraph rejections are moot.

IV. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 1-5, 7, 8 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 6,968,639 issued to Destoumieux ("Destoumieux") in view of U. S. Patent Application No. 2003/172560 issued to Sanjurjo et al ("Sanjurjo "). Applicant has cancelled claims 1-5, 7 and 8. Therefore, the 35 U.S.C. § 103(a) rejections are moot. Applicant, however, shall address Destoumieux in view of Sanjurjo regarding amended claim 12.

Applicant's amended claim 12 contains the limitations of

[a]n ear tag for marking and identifying animals, the ear tag comprising: a male tag component with a punch that, in use, perforates the animal's ear and penetrates into a hollow head of a female tag component under the action of an applicator tool, the female tag component is provided with a sampling device, which has an absorbent material for sampling biological material extracted from the ear of the animal when it is pierced by the punch, said sampling device extending laterally to the female tag component and is separable therefrom, the sampling device further including an attachment to, in use, fix the sampling device to one of the jaws of the applicator tool whereupon opening of the jaws and/or its removal from the animal's ear separates the sampling device from the female tag component.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Destoumieux discloses a substance sampling system in which the male tag component has a punch that is configured in two separable elements. One element forms an organic matter sampling device which, during passage of the male punch through the ear of the animal engages with and holds organic matter punched out of the animal's ear during the application of the ear tag to the animal's ear. After application, this removable punch portion is extracted carrying with

it the organic matter that has been cut out. This organic matter can then be used for DNA purposes in relation to the animal that has been tagged.

Sanjurjo discloses a device for collecting samples of DNA from animals that is adaptable to an ear tag. The device consists of a strip of filter paper attached to the piece of the ear tag bearing the punch and surrounding base. The strip is used to collect blood emerging from the wound produced when tagging. It is asserted in the Office Action that it would be obvious to combine the teachings of Sanjurjo to include in Destoumieux absorbent material. However, it is not asserted in the Office Action why it would be obvious to do this when the whole purpose of Destoumieux is to extract an actual sample of organic material cut from the animal's ear. The inclusion of absorbent material would simply serve no function. There is no compelling reason why a skilled person reading Sanjurjo would even remotely consider that it had any application to a quit different DNA sampling system where a removable punch actually extracts material cut from the animal's ear. It would be simply duplicating what is already achieved by Destoumieux with no valid or obvious reason for doing so.

In fact, it would give rise to exactly the problem identified in Applicant's specification where the absorbent material would remain on the ear tag after the ear tag has been installed thereby making it necessary to carry out the further operation of removing the absorbent material from the ear tag. Not only is this an additional function to be carried out but it also puts an operator in close proximity to an animal which is possibly distressed after the fitting of the ear tag, and therefore not much interested in having someone fiddle with something in the wound formed in the animal's ear in order to remove a specimen carrier. For this reason alone there would be no sense in using the concept of Sanjurjo in relation to Destoumieux when Destoumieux overcomes this precise problem by actually removing, during removal of the applicator tool, the DNA sample.

Applicant's claim 12 has been amended to clarify wording of the claim limitations. Applicant's amended claim 12 is restricted to the sampling device being combined only with the female tag component. This is directly contrary to Sanjurjo where the sampling device is attached to the male component.

A major problem with the arrangement described in Sanjurjo is that the absorbent material is placed on the male tag component and there is therefore a chance that it will never be in contact with the animal's ear, especially as it is located at the bottom of the stem of the male component and may not even collect a sufficient amount of organic material. Also, from a practical viewpoint it is unrealistic to think that (for the reasons outlined above) a person applying a tag to an animal would then go back to the animal's ear (which of course is sensitive due to the wound formed therein) to remove the strip of absorbent material.

Applicant's claimed invention provides the concept of the strip of absorbent material placed on the female part, and therefore, necessarily in contact with the ear or the punch going through the ear to ensure that sufficient organic material is absorbed. Further, Applicant's claimed invention provides a link between the sampling device and the applicator to ensure that, upon application of the tag and removal of the applicator from the animal's ear, the sampling device will be removed from the ear tag in the same movement. This overcomes the need to have to go back to the animal's ear to remove the sampling device.

Therefore, the ear tag and sampling device as device as asserted in Claim 12 is fundamentally different to what is disclosed in Sanjurjo and what would obviously arise if it were valid to consider that the skilled person would even contemplate combining the teachings of Destoumieux and Sanjurjo.

Moreover, neither Destoumieux, Sanjurjo, and therefore, nor the combination of the two teach, disclose or suggest Applicant's claim 12 limitations of

the female tag component is provided with a sampling device, which has an absorbent material for sampling biological material extracted from the ear of the animal when it is pierced by the punch, said sampling device extending laterally to the female tag component and is separable therefrom, the sampling device further including an attachment to, in use, fix the sampling device to one of the jaws of the applicator tool whereupon opening of the jaws and/or its removal from the animal's ear separates the sampling device from the female tag component.

Since neither Destoumieux, Sanjurjo, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 12, as listed above, Applicant's amended claim 12 is not obvious over Destoumieux in view of Sanjurjo since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 12, namely claims 13-20, would also not be obvious over Destoumieux in view of Sanjurjo for the same reason.

CONCLUSION

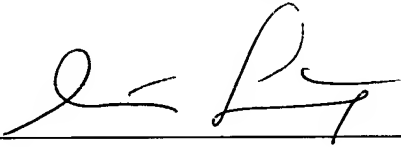
In view of the foregoing, it is submitted that claims 12-20 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

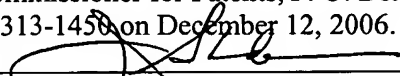
Dated: December 12, 2006
Steven Laut, Reg. No. 47,736

By:  _____

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on December 12, 2006.



Jean Svoboda